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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/540,507

06/23/2005

Basile Bonnemaire

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FOLEY AND LARDNER LLP

SUITE 500

3000 K STREET NW

WASHINGTON, DC 20007

EXAMINER

SINGH, SUNIL

ART UNIT

PAPER NUMBER

3673

MAIL DATE

DELIVERY MODE

09/20/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/540,507

Applicant(s)

BONNEMAIRE ET AL.

Examiner

Sunil Singh

Art Unit

3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 7114885.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they both call for a riser comprising protection means and stretching or tensioning means.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3673

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Loset et al. (US 7114885) or Wipo '895.

Loset et al. and Wipo '895 both call for a riser (18) comprising protection means (20) and stretching or tensioning means (22).

5. Claims 1,2,4,6,7,8,9,11-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Butler et al. (US 5169265).

Art Unit: 3673

Butler et al. discloses a riser (14) comprising protection means (60) and stretching or tension means (26,32,44,46). Collar (36). Chains and or wires ((84),see col. 6 line 23+). Coating (40,40a). The protection means are stacked.

Claim Rejections - 35 USC § 103

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Butler et al. in view of Ortloff et al. '919.

Butler et al. discloses the invention substantially as claimed. However, Butler et al. is silent about the riser (protection means) being suspended from a turret buoy. Ortloff et al teaches a riser (protection means) being suspended from a turret buoy (see Figs. 3, 5). It would have been considered obvious to one of ordinary skill in the art to modify Butler et al. by having the riser suspended from a turret buoy as taught by Ortloff et al. since such a modification allows for weathervane of the vessel.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Butler et al. in view of Poldervaart '781

Butler et al. discloses the invention substantially as claimed. However, Butler et al. is silent about the riser being moored to the seabed. Poldervaart teaches the riser (stretching means) being moored (3) to the seabed. It would have been considered obvious to one of ordinary skill in the art to modify Butler et al. by having the riser (stretching means) moored to the seabed as taught by Poldervaart since such a modification stabilizes the riser.

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Butler et al. in view of Bennett '053

Art Unit: 3673

Butler et al. discloses the invention substantially as claimed. However, Butler et al. is silent about the protection means is conical and truncated. Bennett teaches protection means that is conical and truncated (see Fig. 8). It would have been considered obvious to one of ordinary skill in the art to modify Butler et al. to have conical and truncated protection means as taught by Bennett since such a modification is a mere design choice.

Response to Arguments

9. Applicant's arguments filed 9/5/07 have been fully considered but they are not persuasive. Applicant argues that Loset fails to teach a stretching or tensioning means attached to a lower end of the protection means. The examiner disagrees. Member (22) (stretching/tensioning means) is coupled to protection means (20) see col. 3. Member (22) is a stretching/tensioning means because in Figure 6 when member 22 engages slab 25, member (22) then (stretches/tensions) the protection means.

Applicant argues that Butler fails to teach protection means being submerged and covering at least an upper part of the riser when the riser is submerged and connected to the vessel. It appears that applicant is relying on patentability based on a "when" case basis. Therefore, in the case of a storm, hurricane etc, as water level rises the protection means of Butler would be submerged. Applicant argues that Butler fail to provide means to protect the riser when submerged from impact. It appears that applicant is relying on patentability based on a "when" case basis. Therefore, in the case of a storm, hurricane etc, as water level rises the protection means of Butler would be submerged and member 60 would provide a cushion surface around the riser and

Art Unit: 3673

would be able to withstand impact at least to a small degree. Applicant protection means is submerged "when" the riser is connected to the vessel. It appears that applicant is relying on patentability based on a "when" case basis. Therefore, in the case of a storm, hurricane etc, as water level rises the protection means of Butler would be submerged. Applicant argues that Butler does not teach stretching/tensioning means attached to the protection means. The examiner disagrees. Butler teaches stretching or tension means (26,32,44,46) attached (see Fig. 1) to protection means (60).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunil Singh whose telephone number is (571) 272-7051. The examiner can normally be reached on Monday through Friday 10:30 AM - 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Engle Patricia can be reached on (571) 272-6660. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3673

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Sunil Singh
Primary Examiner
Art Unit 3673



SS



9/14/07